

KCC 4921 (K-C 16,163)
PATIENT

of a second layer using an adhesive composition. The adhesive composition comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight between about 1,000 and about 300,000, and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight between about 3,000 and about 200,000. The first layer is a neck-bonded laminate substrate.

Tanzer discloses an absorbent composite comprising a selectively stretchable liquid permeable first substrate layer, a selectively stretchable second substrate layer and pockets of superabsorbent material formed between the first layer and second layer.¹ In one embodiment, the layers may be a neck-bonded laminate of a necked, inelastic nonwoven filament web to an elastic film.² The pockets are defined by attachment means which serves to join the first and second layers to form a laminate. Suitable attachment means include water sensitive adhesives.³ A secondary attachment means can include water insensitive adhesives.⁴

As noted by the Office, Tanzer fails to teach the adhesive composition required in claim 24, which comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight between about 1,000 and

¹Tanzer specification at page 6, lines 1-5.

²See Tanzer specification at page 3, lines 17-18.

³See Tanzer specification at page 6, lines 15-20.

⁴See Tanzer specification at page 6, lines 26-27.

KCC 4921 (K-C 16,163)
PATENT

about 300,000, and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight between about 3,000 and about 200,000. In an attempt to find each and every element of claim 24 as required by the M.P.E.P. for a determination of *prima facie* obviousness, the Office cites the Yang et al. reference for combination with Tanzer.

Yang et al. disclose thermoplastic elastomer compositions comprising alpha-olefins. Specifically, the thermoplastic elastomer compositions comprise (1) an amorphous polyalphaolefin having a weight average molecular weight of at least about 150,000; and (2) a crystalline polyalphaolefin having a molecular weight of less than about 300,000, provided that the molecular weight of the amorphous polyalphaolefin is greater than the molecular weight of the crystalline polyalphaolefin. Particularly preferred polyalphaolefins for use in the blends are atactic polypropylene and isotactic polypropylene. In a laundry list of eighteen (18) uses⁵, Yang et al. disclose adhesives as one use for their thermoplastic elastomers.⁶ Yang et al., however, fail to set forth any disclosure of what types of substrates are suitable for binding with the elastomer composition. Specifically, Yang et al. do not teach or suggest

⁵At column 20, lines 24-28, Yang et al. list the following multitude of uses: molded parts, films, tubing, hose, sheeting, wire and cable coating, adhesives, shoesoles, bumpers, gaskets, bellows, films, fibers, elastic fibers, nonwovens, surgical gowns, and medical devices.

⁶Yang et al. reference at column 20, lines 21-36.

KCC 4921 (K-C 16,163)
PATENT

that their elastomer composition is a suitable adhesive for use within a diaper or similar product.⁷

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2143 requires that the Office must meet three criteria: (1) the prior art reference must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under (2) above, as there is no motivation or suggestion to combine the Tanzer and Yang et al. references to arrive at Applicants' claim 24.

As noted in M.P.E.P. §2142, in establishing obviousness, the Office must show references that teach all of the claimed limitations along with some motivation or suggestion, either in the references themselves or in knowledge generally available to one skilled in the art, to combine the references and arrive at

⁷ It is noted that the Office states that Yang et al. provide motivation to combine the cited references as Yang et al. disclose that their compositions may be used in diaper waist bands. Although Yang et al. do mention diaper waist bands, a close reading of Yang et al. indicates clearly that the diaper waist bands are produced using elastic films produced using the elastomer compositions taught by Yang et al. Yang et al. disclose films as a second use of their composition, separate and distinct from that of using the composition as an adhesive. No where does the Yang et al. reference disclose or suggest using its elastomer composition as an adhesive in any absorbent product or diaper waist band, let alone a diaper or to attach a neck-bonded laminate substrate to a second substrate as required in the instant claim 24.

KCC 4921 (K-C 16,163)
PATENT

the claimed subject matter.⁸ The mere fact that the references can be combined to arrive at the claimed subject matter does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. In re Mill, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). A close reading of the cited references clearly indicates that one skilled in the art would not have been so motivated and, without Applicants' disclosure as a blueprint (which the Office had the benefit of utilizing), such a combination of the Tanzer and Yang et al. references would not have been made.⁹

The Office asserts that Yang et al. provide sufficient motivation to use the thermoplastic elastomer composition of Yang et al. in the absorbent composition of Tanzer due to

⁸As further set forth in M.P.E.P. §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the reference itself, or in the knowledge generally available to one of ordinary skill in the art.

⁹M.P.E.P. §2142 further provides that in order to reach a proper determination under 35 U.S.C. §103(a), the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. Knowledge of Applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences." The tendency to resort to "hindsight" based upon Applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, as stated by the Federal Circuit, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Grain Processing Corp. v. American-Maize-Products, Co., 840 F.2d 902, 904 (Fed. Cir. 1988).

KCC 4921 (K-C 16,163)
PATIENT

flexibility and strength of the composition, both which are important properties in absorbent materials such as diapers and medical gowns.

As stated by the Federal Circuit in *In re Gorman*, when "determining whether a new combination of known elements would have been obvious to one of ordinary skill... the test is whether the teachings of the prior art, *taken as a whole*, would have made obvious the claimed invention."¹⁰

Applicants note that the Office states that it would not be proper to ignore the disclosure of the use of the composition of Yang et al. as an adhesive. Applicants agree; however, it is not proper for the Office to find the required motivation to combine Yang et al. with Tanzer simply because Yang et al. state that their composition may be used as an adhesive. This generic statement, without anything further, is not sufficient motivation for one skilled in the art, at the time Applicants' invention was made, to combine the cited references and arrive at Applicants' invention.

With all due respect, it appears that the Office has used impermissible hindsight analysis and reconstruction when combining the Tanzer reference with the Yang et al. reference. Notably, it would be clear to one skilled in the art reading

¹⁰933 F.2d , 986, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991); See also *In re Young*, 927 F2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); M.P.E.P. § 2143.01 ("The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts.") This requires that all adhesives should be considered.

KCC 4921 (K-C 16,163)
PATIENT

Tanzer that a strong and flexible adhesive be used to bond the substrates described therein. It would be clear that using an adhesive that is weak would not work as the product would fall apart. It would also be clear that using an adhesive that does not flex would be equally problematic. There are, however, a myriad of strong, flexible adhesives in the art, many of which are used in diaper and other absorbent substrate applications. Yang et al. do not even mention such use. What is important is that there is no motivation or suggestion to use the composition of Yang et al. over any of the other enormous number of adhesives described in the art, which are strong and flexible.

There is simply no motivation to combine the Tanzer and Yang et al. references to arrive at the instant claim 24, and claim 24 cannot be said to be obvious in view of the cited references.

Claims 25-33 are dependent upon claim 24 and are patentable for the same reasons as claim 24 set forth above, as well as for the additional elements they require.

Claim 70 is similar to claim 24 and is directed to a laminate structure comprising a first neck-bonded laminate substrate and a second neck-bonded laminate substrate, wherein the first neck-bonded laminate substrate is bonded to the second neck-bonded laminate substrate with an adhesive composition. The adhesive composition comprises an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight of from about 1,000 to about 300,000 and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight of from about 3,000 to about 200,000.

KCC 4921 (K-C 16,163)
PATIENT

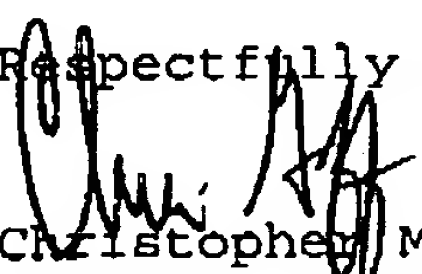
Both Tanzer and Yang et al. are discussed above.

As stated above, Tanzer fails to disclose an adhesive composition comprising an atactic polymer having a degree of crystallinity of less than about 20% and a number-average molecular weight of from about 1,000 to about 300,000 and an isotactic polymer having a degree of crystallinity of at least about 40% and a number-average molecular weight of from about 3,000 to about 200,000. Further, as stated above, one skilled in the art would not and could not find motivation to combine the composition of Yang et al. with the substrates of Tanzer to arrive at instant claim 70. As such, claim 70 is not obvious over the cited references.

Claims 71-82 are dependent upon claim 70 and are patentable for the same reasons as claim 70 set forth above, as well as for the additional elements they require.

In view of the above, Applicants respectfully request favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee deficiency in connection with this Letter To Patent And Trademark Office to Deposit Account Number 19-1345 in the name of Senniger, Powers, Leavitt & Roedel.

Respectfully Submitted,


Christopher M. Goff, Reg. No. 41,785
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
314-231-5400

CMG/JMB/dhm
Via Facsimile (703) 872-9306